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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/887,505	07/02/1997	ROBERT L. KILKUSKIE	HYZ-040CIP	1117

7590

04/09/2003

HALE AND DORR  
60 STATE STREET  
BOSTON, MA 02109

EXAMINER

JOHANNSEN, DIANA B

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

08/887,505

Applicant(s)

KILKUSKIE ET AL.

Examiner

Diana B. Johannsen

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: Re: (a), see Attachment. Re: (d), applicant has proposed adding a claim 46.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance ~~because~~: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 22-24 and 26.

Claim(s) objected to: none.

Claim(s) rejected: 1-21, 25, 27-31 and 42-45.

Claim(s) withdrawn from consideration: none.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 5. does NOT place the application in condition for allowance ~~because~~ for the reasons set forth on the Attachment to this advisory action and for the reasons of record in view of the non-entry of the after final amendment.

**ATTACHMENT TO ADVISORY ACTION**

1. This application has been transferred from Examiner Janell Taylor Cleveland to Examiner Diana Johannsen.

***New issues raised.***

2. Applicant's proposed amendments raise the following new issues under 35 U.S.C. 103 that would require further search and consideration. Applicant has proposed amending claim 43 such that it requires two oligonucleotides that are "complementary to different non-contiguous regions of HCV," whereas the claim previously merely required two oligonucleotides that were "different." The addition of this new functional requirement would necessitate a new search and consideration of whether a composition comprising two oligonucleotides of claim 2 that are "complementary to different non-contiguous regions of HCV" is obvious.

3. Applicant's proposed amendments raise the following new issues under 35 U.S.C. 112, second paragraph that would require further consideration. Applicant has proposed amending claim 43 to recite the limitation "the second oligonucleotide" for which antecedent basis is lacking.

4. Applicant's proposed amendments would also necessitate a new objection to claim 29, as applicant has amended the claim to refer to a "nucleoide" sequence.

***Response to Arguments***

5. Regarding the rejection of claims 2-6, 8-20, 25, 27-28, 30, and 43 over Hogan et al in view of Maertens et al, applicant's arguments have been thoroughly considered but are not persuasive. It is again noted that Hogan et al do disclose noncontiguous

molecules, as discussed on page 7 of the Final Rejection of paper no. 30. Further, the Maertens et al reference was not cited for a teaching of noncontiguous molecules, but merely for its teaching of 5' untranslated target molecules. Accordingly, applicant's arguments are not persuasive.

6. Regarding the rejection of claims 7, 31, 43 and 45 over Hogan et al in view of Maertens et al and Seki et al, applicant's arguments have been thoroughly considered but are not persuasive. The claims are drawn to molecules that include SEQ ID NO: 47 (see claim 7) and SEQ ID NO: 160 (claim 31), not to molecules consisting of these sequences, or to, e.g., molecules that include these particular sequences in addition to another particular sequence. It is again noted that the Hogan et al reference, not the Seki et al reference, was cited for a teaching of noncontiguous molecules; Seki et al was cited for its teaching of particular sequences. Accordingly, applicant's arguments are not persuasive.

7. Regarding the rejection of claims 21 and 29 over Hogan et al in view of Cha et al, applicant's arguments have been thoroughly considered but are not persuasive. The recitation "as set forth in Table 1A" in claim 21 does not limit the claim to "various non-obvious modifications" of the sequence included in that Table. The claim as written is sufficiently broad so as to encompass an oligonucleotide "having" a sequence selected from SEQ ID Nos 119-130, which sequences are depicted in the Table. Applicant's Sequence Listing indicates that the molecule type for SEQ ID NO: 122 is "DNA/RNA." Accordingly, applicant's arguments are not persuasive. (Regarding claim 29, it is noted that applicant's proposed amendment to the claim has not been entered).


**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 703/305-0761. The examiner can normally be reached on Monday-Friday, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached at 703/308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0196.

Diana B. Johannsen  
April 7, 2003

  
CARLA J. MYERS  
PRIMARY EXAMINER